

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: Carl. E. Whitcomb

Appl. Serial No.: 10/075,096

Filed: October 29, 2001

Title: Root Growth Barrier and Method

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Examiner: Son T. Nguyen

Group Art Unit: 3643

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REPLY BRIEF OF APPELLANT

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(1) STATUS OF THE CLAIMS

The status of all claims in the application under appeal is as follows: claims 1-65 stand rejected. All of the rejected claims 1-65 are under appeal.

(2) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Withdrawn Rejection

The Examiner has withdrawn his rejection of claims 1-48, 63-65 as being unpatentable under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Remaining Rejections to be Reviewed on Appeal

a. Whether claims 1, 2, 15, 18, 19, 29, 30, 46-48 are unpatentable under 35 U.S.C. 102(b) over Reynolds et al. (3080680).

b. Whether claims 3, 25, 26, 31, 32, 64 and 65 are unpatentable under 35 U.S.C. 103(a) over Reynolds et al (3080680).

c. Whether claims 4-11, 27-28 and 33-38, 42, 44, 49-53, 55-57, 59-62 are unpatentable under 35 U.S.C. 103(a) over Reynolds et al. as applied to claims 1 & 29 above, and further in view of Reiger (6202348).

d. Whether claim 12 is unpatentable under 35 U.S.C. 103(a) over Reynolds, et al. as modified by Reiger as applied to claims 1, 4, 10, 11 above, and further in view of Thomas (5311700).

e. Whether claims 13-14, 16, 41, and 63 are unpatentable over Reynolds et al. as modified by Reiger as applied to claims 1, 4 above, and further in view of Berlitz et al (GB 2073567A).

f. Whether claims 17, 21, 22 and 24 are unpatentable under 35 U.S.C. 103(a) over Reynolds et al. as applied to claim 1 above, and further in view of Van der Goorbergh (EP 300578 A3).

g. Whether claims 20 and 23 are unpatentable under 35 U.S.C. 103(a) over Reynolds et al. as applied to claim 1 above, and further in view of Flasch, Jr. (5852896).

h. Whether claims 39-40 are unpatentable over Reynolds et al. as modified by Reiger as applied to claims 29, 36 above, and further in view of Flasch, Jr. (as above).

i. Whether claim 43 is unpatentable under 35 U.S.C. 103(a) over Reynolds et al. as applied to claim 29 above, and further in view of Kalpin (3094810).

j. Whether claims 45 is unpatentable under 35 U.S.C. 103(a) over Reynolds et al. as modified by Reiger as applied to claims 29, 33 above, and further in view of Billings (6223466).

k. Whether claims 54 and 58 are unpatentable under 35 U.S.C. 103(a) over Reynolds et al. as modified by Reiger as applied to claim 29 above, and further in view of Van der Goorbergh (as above) and Berlitz et al. (as above).

(3) ARGUMENT

The Applicant believes that the previously filed Second Amended Appeal Brief accurately states the Applicant's position, but wishes to address a limited number of statements made by the Examiner in the Answer of June 4, 2007.

The Examiner states that "to further prove the Examiner's position regarding the roots, Reiger, *as agreed by Appellant*, teaches a root-tip-trapping material . . ." (Answer, page 6, lines 2-4; *emphasis added by Appellant*). The Appellant would point out that the Examiner fails to cite where Appellant might have made such an agreement, and Appellant does not believe such an agreement was made. Appellant has clearly and consistently asserted that Reynolds and/or Reiger do not teach, show or suggest the claimed structure for root-tip-trapping.

The Examiner states that "*roots are very strong and can penetrate through material (even concrete)*"; thus, unless the bonding is a super glue or a permanent bond of some sort, some roots will extend and grow along the interface of the outer and inner layers of Appellant's barrier/container, which is no different from that of Reynolds." (Answer, page 6, lines 2-4; *emphasis added by Appellant*). The Examiner's assertion that roots can penetrate concrete is unfounded, incorrect, and is evidence that the Examiner is taking improper official notice of alleged facts that have no basis. Roots can not "penetrate" concrete, but may grow into cracks that already exist in concrete. Rather, roots extend through growth that occurs at the tip of the

root until that tip dies or becomes trapped. When a root tip encounters an obstruction, the root tip may become re-directed and continue to extend in the new direction. However, the amount of axial force that a root tip applies when it encounters an object is insufficient to allow the root tip to penetrate concrete.

The Examiner states that “[a]t some point in time, the roots will grow between the layer of the barrier of Appellant since the bonding is not permanent or designated as a strong or super bond because the barrier is designed to slowly disintegrate after all.” (Answer, page 8, lines 7-10; citing page 8, 2nd paragraph of Appellant’s specification). The Appellant would like to clarify that the cited portion of Appellant’s specification is describing an alternative embodiment of the invention in which both root-tip-trapping and the root-impenetrable layers are biodegradable. (See Specification, page 8, lines 21-25). However, it should be understood that other embodiments of the claimed invention are not readily biodegradable.

The Examiner states that “[R]eynolds et al. teaches a porous fibrous material such as peat moss, thus, this material has some sort of density having elements per square inch.” (Answer, page 8, lines 20-21). However, the Examiner was responding to Appellants argument that Reynolds’ peat moss does not trap the tips of roots and does not have a surface density of root-tip-trapping elements, such as 10 and 100 root-tip-trapping elements as set out in claims 3 and 65, respectively.

WHEREFORE, Appellant respectfully requests that the Board find that the claims 1-65 presented on appeal are patentable.

Respectfully submitted,

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